PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of: SRINIVASAN, et al.	Group Art Unit: 3622
	Examiner: ALVAREZ, RAQUEL
Serial No.: 10/001,662	
Filed: October 18, 2001	
Confirmation No.: 4124	
Atty. File No.: 1585C (42059-01380)	
For: "METHOD AND APPARATUS FOR BROADCASTING INFORMATION OVER A NETWORK"	

STATEMENT OF REASONS FOR REQUESTING REVIEW

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
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Dear Sir or Madam:

The Applicant submits this Statement of Reasons for Requesting Review as an attachment to form PTO/SB/33 (07/05) and pursuant to Official Gazette Notices, July 12, 2005, Notice 12 ("New Pre-Appeal Brief Conference Pilot Program"). Review is respectfully requested for the above Patent Application because, among other reasons, the Examiner has not shown where all of the claim elements of the applicant's claims are taught as required in a *prima facie* rejection of independent claims 1 and 22 and their associated dependent claims 2 – 6, 8 – 11, 23 - 25.

The Examiner has stated that all claim limitations were addressed in the Non Final Office Action mailed on May 22, 2006. The Examiner's communication of May 25, 2006 is an interview summary - no rejections were discussed or mentioned in that

summary. In the Examiner's Non Final Office Action (i.e., having a mailing date of January 18, 2006), the Examiner rejected all claims but only addressed claim limitations associated with claims 1 and 22. The Examiner never addressed the broadcasting multimedia information of claim 2, the monitoring of system users of claim 4, the querying of system users of claim 9, the presenting of an interactive component of claim 10, the reading of an IP address of claim 11, the program source of claim 22, or the simultaneous transmission of claim 24. Rather, the Examiner illegitimately "lumped" these dependent claims together in the rejections of their associated independent claims without addressing them. See M.P.E.P § 707.07(d). The Examiner only addressed these claims in the Final Office Action (i.e., with a mailing date of Aug. 11, 2006) because of the Applicant's Non Final Office Action response filed on May 22, 2006.

The Examiner also incorrectly addressed the elements of independent claims 1 and 22. In claim 1, the Applicant recites a method of transmitting multimedia from a network server information over a data network. The method includes, among other things, receiving through a screen display demographic information for the at least one system user and using the IP address to access at least one database to retrieve demographic information stored therein associated with the at least one system user. Based on selection of a hypertext link (i.e., by the system user), a multimedia presentation is selected from a computer memory and transmitted to the system user's remotely located computer. The method also includes detecting an inserted commercial break during the transmission of the multimedia presentation and, based on the demographic information, accessing a commercial database and retrieving at least one commercial associated with the demographics for the system user. The method also includes transmitting the commercial to the user during the commercial break.

The Examiner stated that Rangan, at column 20, lines 52 – 60 teaches the steps of receiving through a screen display demographic information for the system user and using the IP address to access a database and retrieve demographic information that is associated with the system user. Here, Rangan merely states that a client subscriber/user/viewer (SUV) may click to a hyper video commercial to initiate a Web transaction (column 20, lines 49 and 50 of Rangan) and that the feedback from the transaction results in on-the-fly commercial insertion that may be tuned to local

demographic conditions and user profiles. Based on the Applicant's arguments, the Examiner countered in the Final Office Action with new citations of Rangan at column 29, lines 35 – 39. Again, the Applicant disagrees because Rangan does not state that demographic information for a system user is received through a screen display. In fact, Rangan does not mention or even suggest a screen display for entering demographic information in any form anywhere.

Additionally, Rangan's mere statement of commercial insertion in column 20, line 55 is not the same as the commercial transmission of a retrieved commercial during a commercial break. Rather, Rangan's alleged teaching of a commercial insertion generally regards insertion of hypertext links within video content to make "hypervideo", which allows a user to select additional video content during presentation of the hypervideo (e.g., Rangan explicitly states that "in accordance with the present invention, the insertion is not of clips… but rather of hyperlinks" at column 20, lines 15 – 22).

Regardless, Wachob is not analogous art. For example, Rangan teaches selection of hypertext links within video content for distribution over the Internet. Wachob teaches commercial insertion during predetermined times via cable television (see e.g., column 4, lines 30-35 of Wachob). The Applicant respectfully disagrees because the types of content are totally different. Rangan delivers audio and/or video content digitally via Internet protocols through an Internet network (see e.g., Figure 1 and column 24, lines 32 - 51 of Rangan). Wachob delivers audio and/or video content in an analog fashion via radio frequency AM or FM modulation schemes (see e.g., Figure 1 and column 4, lines 56 - 68 and column 1 – 7 of Wachob). To anyone skilled in the art, this is simply unreasonable. See e.g., *In re Oetiker*, 977 F.2d 1443, 1447 (C.A.Fed.,1992). Moreover, there is no reasonable expectation of success in the combination because combining Rangan's internet technology with Wachob's analog television technology (i.e., Wachob) is not possible. See In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). See also M.P.E.P. § 2143.02. Such is even illustrated by Rangan when Rangan explicitly states, at column 29, lines 39 – 42, that Rangan's teachings are "in marked contrast to conventional broadcast television where there is no interactivity with the viewer and/or the viewers video playback, especially including commercials."

Other examples of a lack of motivation to combine are found in claim 4. In claim 4, the Applicant recites a step of monitoring the at least one system user receiving the multimedia presentation and accumulating demographic information. Rangan explicitly teaches away from the Applicant's claim when Rangan states "This knowledge is not gained by any sort of insidious monitoring of the Client SUVs. Instead, it should be recognized that the Client SUVs from time to time identify, and link, to the (hyper)video that each wishes to view." Column 18, lines 7 – 11 of Rangan.

Turning now to claim 22, the Applicant recites a network server configured for transmitting multimedia information over a data network. The network server includes a schedule database that stores one or more schedules for the multimedia information as well as one or more screen displays which are presentable and through which the system users enter demographic information. The system also includes a program source from which the multimedia information may be retrieved and a commercial database that stores commercials that are transmittable to at least one system user and that are associated with one or more types of demographic information. The network server also includes a processor that selects one or more commercials associated with the demographic information entered by the system users and transmits those selected commercials with selected multimedia information.

The Examiner rejected claim 22 based, in part, on Official Notice stating that it is old and well known "to schedule when certain information is to be scheduled in order to designate a fixed time for an event". Even if the Examiner is correct, the Examiner failed to address where a schedule database stores one or more screen displays which are presentable and through which the system users enter demographic information. The Examiner cannot use hindsight by simply picking and choosing elements to depreciate the claimed invention. *In re Fine*, 837 F.2d 1071, 1075 (C.A.Fed., 1988); see also, M.P.E.P. § 2143.03. The Applicant traversed the Examiner's Official Notice and the Examiner thereafter cited "In re Boon" at M.P.E.P. § 2144.03 stating that the Applicant did not adequately traverse the Examiner's Official Notice. There is no *In re Boon* citation at M.P.E.P. § 2144.03, so the Applicant cannot even respond.

The Applicant believes that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation

would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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